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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/739,317 | 12/19/2000 | Simon G. Thompson | 36-1533 | 2567 |
| 23117 | 7590 | 10/20/2006 | EXAMINER NAHAR, QAMRUN | |
| NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203 | | | ART UNIT 2191 | PAPER NUMBER |

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/739,317 | Applicant(s) THOMPSON ET AL. | |
| | Examiner Qamrun Nahar | Art Unit 2191 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 07/28/2006.
2. The rejection under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter to claims 1-11 and 15-16 is withdrawn in view of applicant's remarks/arguments.
3. The rejection on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/589,200 in view of Ernst (U.S. 5,890,133) to claims 1-20 is withdrawn in view of applicant's submission of terminal disclaimer filed on 07/28/2006.
4. Claims 1-20 are pending.

Terminal Disclaimer

5. The terminal disclaimer filed on 07/28/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application No. 09/589,200 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
7. Claims 12-14 and 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Claims 12 and 13 appear to be a system (apparatus) of software alone, lacking the necessary physical components (hardware) to constitute a machine or a manufacture under 101. Since claims 12 and 13 are clearly not a process or a composition of matter, they appear to fail to fall within a statutory category and thus non-statutory.

Claims 14 and 17-20 are rejected for failing to cure the deficiencies of the above rejected non-statutory claims 12 and 13.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over S. Jablonski, "On the Complementarity of Workflow Management and Business Process Modeling", 1995 (hereinafter "Jablonski") in view of Schmidt, et al. "Extending Aspect-Oriented Programming in order to Flexibly Support Workflows", 1998 (hereinafter "Schmidt").

Per Claim 1:

Jablonski teaches storing at least one generic process plan ("The first step is mandatory ... obtain a valid *workflow specification*." on pg. 36, 2nd column, par. 6 to pg. 37, 1st column, par. 1); storing at least one non-generic process element containing a predetermined pattern ("Functional Perspective ... *activities*" on pg. 37, 1st column, par. 4). Jablonski does not

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explicitly teach searching said at least one generic process plan for the predetermined pattern contained by at least one non-generic process element, on detection of the predetermined pattern, inserting content from said at least one non-generic process element into the generic process plan to generate a process plan, and outputting the generated process plan, wherein instructions for the insertion of said content in said step of inserting content are coded into said at least one non-generic process element.

Schmidt teaches searching said at least one generic process plan for the predetermined pattern contained by at least one non-generic process element, on detection of the predetermined pattern, inserting content from said at least one non-generic process element into the generic process plan to generate a process plan, and outputting the generated process plan, wherein instructions for the insertion of said content in said step of inserting content are coded into said at least one non-generic process element (“Workflow-aspects ...” on pg. 4; “Use the workflow-aspects as domain-specific-aspect decomposition” on pg. 7; see “aspect specifications” and “aspect implementations” in the figure on pg. 7; where the “Aspect weaver” inserts the content of the “aspect implementations” into the “workflow-specification” to generate the “Workflow application”).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Jablonski to include searching said at least one generic process plan for the predetermined pattern contained by at least one non-generic process element, on detection of the predetermined pattern, inserting content from said at least one non-generic process element into the generic process plan to generate a process plan, and outputting the generated process plan, wherein instructions for the insertion of said content

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in said step of inserting content are coded into said at least one non-generic process element using the teaching of Schmidt. The modification would be obvious because one of ordinary skill in the art would be motivated to separate aspects of a business domain (Schmidt, on pg. 6).

Per Claim 2:

The rejection of claim 1 is incorporated, and Jablonski further teaches the steps of receiving for storage at least one generic process plan and receiving for storage at least one non-generic process element (on pg. 36, 2nd column, par. 6 to pg. 37, 1st column, par. 1; and on pg. 37, 1st column, par. 4).

Per Claim 3:

The rejection of claim 1 is incorporated, and Jablonski further teaches each stored generic process plan is indexed in accordance with a goal to be achieved by the plan, receiving a goal input, and selecting a generic process plan for searching, said selection being in accordance with the received goal input (on pg. 34, 2nd column, par. 1, lines 13-18).

Per Claim 4:

The rejection of claim 1 is incorporated, and Jablonski further teaches at least one non-generic process element comprises resource information, identifying one or more resources to support a process step in a generated process plan (on pg. 37, 1st column, par. 6, lines 1-13).

Per Claim 5:

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The rejection of claim 4 is incorporated, and Jablonski further teaches each stored non-generic process element comprising resource information is indexed in accordance with one or more relevant resources (on pg. 37, 1st column, par. 6, lines 1-13).

Per Claim 6:

The rejection of claim 1 is incorporated, and Schmidt further teaches wherein content of at least one inserted process element comprises data (“Workflow-aspects ...” on pg. 4).

Per Claim 7:

The rejection of claim 1 is incorporated, and Jablonski further teaches at least one non-generic process element comprises context specific method steps or data and is indexed for storage according to a relevant context (“Functional Perspective ... *activities*” on pg. 37, 1st column, par. 4).

Per Claim 8:

The rejection of claim 7 is incorporated, and Jablonski further teaches the context for at least one non-generic process element is service type (“Functional Perspective ... *activities*” on pg. 37, 1st column, par. 4).

Per Claim 9:

The rejection of claim 7 is incorporated, and Jablonski further teaches the context for at least one non-generic process element is customer type (on pg. 37, 1st column, par. 6, lines 1-13).

Per Claim 10:

The rejection of claim 1 is incorporated, and Schmidt further teaches selecting an item of content from two or more alternative items of content, said two or more alternative items of content being identified from said coded instructions provided by said at least one non-generic process element, and inserting the selected content into the generic process plan in generating a process plan (“Workflow-aspects ...” on pg. 4).

Per Claim 11:

The rejection of claim 10 is incorporated, and Schmidt further teaches wherein the selection is domain specific (“Use the workflow-aspects as domain-specific-aspect decomposition” on pg. 7).

Per Claim 12:

This is an apparatus version of the claimed method discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

Per Claims 13-14:

These are apparatus versions of the claimed method discussed above (claims 1, 10 and 11), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

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Per Claim 15:

The rejection of claim 1 is incorporated, and Schmidt further teaches wherein said content inserted from said at least one non-generic process element introduces a new process step into the generic process plan (see the figure on pg. 7).

Per Claim 16:

The rejection of claim 1 is incorporated, and Schmidt further teaches wherein said content inserted from said at least one non-generic process element advises an existing step of the generic process plan (see the figure on pg. 7).

Per Claims 17-18:

These are apparatus versions of the claimed method discussed above (claims 15-16, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

Per Claims 19-20:

These are apparatus versions of the claimed method discussed above (claims 15-16, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also obvious.

Response to Arguments

10. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The Examiner suggests the applicant to amend claims 1, 12 and 13 to include recitations such as "process aspects" and "generic process pattern" as described on pg. 7, par. 4 to pg. 8, par. 3 of the instant application.

12. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 9:30 AM to 6:00 PM.

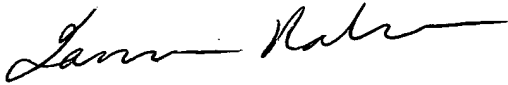
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y Zhen, can be reached on (571) 272-3708. The fax phone number for the organization where this application or processing is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

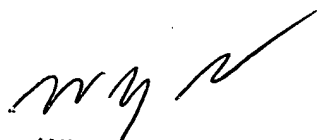
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



QN
October 13, 2006



WEI ZHEN
SUPERVISORY PATENT EXAMINER